

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed August 22, 2003.

I. Present Status of Patent Application

Upon entry of this response claims 6 - 7, and 10 are pending in the present application. In particular, Applicants have amended claims 6 and 10 and have canceled claims 1 - 2 and 11 - 12 (claims 3-5 and 8-9 were previously canceled) without prejudice, waiver, or disclaimer. Applicants have canceled claims 1 - 2 and 11 - 12 merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicants reserve the right to pursue the subject matter of these canceled claims in a continuing application, if Applicants so choose, and do not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

II. Examiner Interview

A telephone interview was conducted with Applicants' attorney, Christopher Guinn, on November 13, 2003. Applicants appreciate the courtesy the Examiner extended to their representative in discussing this case. The discussion was directed to the Office Action's rejection of claim 6, and particularly as to whether the functional language at issue must be considered in the rejection of the claim.

From the discussion, and a follow-up voice mail left for Applicants' attorney, the Examiner apparently agreed that functional language should be considered. However, the Examiner believed that claim 6 was properly rejected because the claim language reciting "the third transistor device configured with predetermined parasitic characteristics that improve the

effective parasitic characteristics of the transistor circuit” is unclear. Specifically, the Examiner indicated the claim should indicate how the parasitic effects are improved.

Applicants have amended claim 6 to recite that the third transistor device is “configured with predetermined parasitic characteristics that improve the effect of the parasitic characteristics of the transistor circuit when the control signal enables the first transistor device, the second transistor device, and the third transistor device” to further define how the parasitic effects are improved. Support for the amendment, and extensive detail as to how the parasitic effects of the circuit are improved when each of the transistors are enabled is found in the detailed description on pages 11-14 and in FIGs. 12-16. Once skilled in the art at the time of the invention would understand from the language of the claims, and the supporting disclosure, how the effects of the parasitic characteristics of the transistor circuit is improved “when the control signal enables the first transistor device, the second transistor device, and the third transistor device” as recited in claim 6.

III. Rejections to Claims 1 and 11 Under 35 U.S.C. §112 are Moot

Claim 1 is rejected under 35 U.S.C. §112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Claim 11 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Applicants submit that these rejections are rendered moot in light of the cancellation of claims 1 and 11.

IV. Claim 6 Complies with 35 U.S.C. §112, Second Paragraph

Claim 6 is rejected under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Office Action alleges that “the effective (actual) parasitic

capacitance cannot be improved or reduced.” (Office Action, page 3). However, the Office Action indicates that “the effect of the effective (actual) parasitic capacitance of the circuit can be improved or reduced by incorporating other circuits [sic] to the existing circuit.” (Office Action, page 3).

Applicants submit that the claim as previously presented is definite and not misdescriptive. However, in an effort to expedite prosecution of the application, Applicants have amended claim 6 to recite that the third transistor device is “configured with predetermined parasitic characteristics that improve the effect of the parasitic characteristics of the transistor circuit,” as suggested in the Office Action.

While the Office Action did not reject claim 10 under §112, second paragraph, Applicants have also amended claim 10, which depends from claim 6, for consistency.

Therefore, Applicants respectfully submit that the language “the third transistor device configured with predetermined characteristics that improve the effect of the parasitic characteristics of the transistor circuit” as recited in independent claim 6 is not indefinite. Rather, this language clearly points out and distinctly claims the subject matter which Applicants regard as the invention. Accordingly, Applicants request that the Examiner reconsider and withdraw the rejection of independent claim 6 under 35 U.S.C. 112, second paragraph.

V. Rejections of Claims 1, 2, 11, and 12 Under 35 U.S.C. §102 are Moot

The Office Action rejects claims 1 and 2 under 35 U.S.C. §102(b) as allegedly anticipated by U.S. Patent No. 4,678,947 to Huijsing (“Huijsing”). The Office Action also rejects claims 1 and 2 under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,380,644 to Iliasevitch (“Iliasevitch”). Furthermore, the Office Action rejects claims 11 and 12 under 35 U.S.C. §102(b) and §102(e) as being anticipated by U.S. Patent No. 4,574,203 to

Baba (“Baba”) and U.S. Patent No. 6,605,963 to Kitamono (“Kitamono”), respectively.

Without acquiescing to this argument, Applicants submit that this rejection is moot in light of the cancellation of claims 1, 2, 11, and 12.

VI. Claims 6, 7, and 10 are Patentable Over Lin

The Office Action rejects claims 6, 7, and 10 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 4,752,403 to Lin (“Lin”). The Office Action indicates that Lin discloses the first switch node, second switch node, first transistor device, second transistor device, and a third transistor device as in claim 6. The Office Action further alleges that “the recitation ‘the third transistor device configured with predetermined characteristics that improve the effective parasitic characteristics of the transistor circuit’ is merely ‘functional language’ and thus cannot be relied upon to distinguish over Lin, *i.e.*, since the reference meets all of the claim structures (and the function performed by that structure).” (Office Action, page 4). Furthermore, the Office Action alleges that “apparatus claims, to be patentable over the prior art by structure, not by the function (result) of that structure.” (Office Action, pages 4 – 5).

The Examiner has not given patentable weight to Applicants’ functional recitations contained in Applicant’s claims because the claims are directed to an apparatus. Applicants, however, may use functional language and such language must be considered when making a prior art rejection. As provided in the Manual of Examining Procedure (MPEP):

Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought.

MPEP § 2173.01. The MPEP provides further guidance in the context of 35 U.S.C. § 112, second paragraph:

The essential inquiry pertaining to this [35 U.S.C. § 112] requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

MPEP § 2173.01.

The MPEP also provides guidance specific to functional limitations in MPEP 2173.05(g). As provided therein:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability of purpose this is served by the recited element, ingredient or step.

MPEP § 2173.05(g) (*Emphasis added*).

In view of the above, and in accordance with the Examiner interview conducted November 13, 2003, Applicants' recitation of "the third transistor device configured with predetermined parasitic characteristics that improve the effect of the parasitic characteristics of the transistor circuit when the control signal enables the first transistor device, the second transistor device, and the third transistor device" is not indefinite and must be considered for what it fairly conveys.

Lin does not teach, suggest, or disclose a third transistor device "configured with predetermined parasitic characteristics that improve the effect of the parasitic characteristics of the transistor circuit when the control signal enables the first transistor device, the second transistor device, and the third transistor device" as in claim 6. Looking to FIG. 1 of Lin, when transistor device 17 is enabled, transistor device 11 is disabled. Likewise, when transistor device 17 is disabled, transistor device 11 is enabled. (Col. 3, lines 57 – 60). Thus, at most, Lin discloses that only two of the four switches are enabled at a time. Since transistor 11 is disabled when transistor devices 17 and 12 are enabled, even if the capacitance of transistor 17 and 12 are put into parallel, this would only increase the effect of the parasitic capacitance without decreasing the effect of the parasitic resistance of the circuit. Unlike Lin, claim 6 requires that the parasitic effects are improved "when the control signal enables the first transistor device, the second transistor device, and the third transistor device." Thus, Lin does not show a third transistor device "configured with predetermined parasitic characteristics that improve the effect of the parasitic characteristics of the transistor circuit when the control signal enables the first transistor device, the second transistor device, and the third transistor device" as in claim 6.

Accordingly, and for at least the reasons set forth above, independent claim 6 is believed to be allowable over Lin. Furthermore, because independent claim 6 is believed to

be allowable over the prior art of record, dependent claims 7 and 10 (which depend from independent claim 6) are allowable as a matter of law for at least the reason that they contain all the features and elements of the corresponding independent claim. Accordingly, Applicants request that the rejection to claims 6, 7 and 10 be withdrawn and the claims allowed.

Claims 7 and 10

The Office Action rejects claims 7 and 10 under 35 U.S.C. §102(b) as allegedly being anticipated by Lin. Without acquiescing to this argument, Applicants submit that this rejection is rendered moot in light of any of the arguments made above and, therefore, claims 7 and 10 are allowable as a matter of law for at least the reason that claims 7 and 10 contain all the features and elements of independent claim 6. For at least this reason, Applicants request that the rejection of claims 7 and 10 be withdrawn.

VII. Rejection to Claim 2 Under 35 U.S.C. §103 is Moot

The Office Action rejects claim 2 under 35 U.S.C. 103(a) as allegedly being obvious over Huijsing. Claim 2 has been canceled, and therefore, Applicants submit that the rejection to claim 2 under 35 U.S.C. §103(a) is moot.

CONCLUSION

The Applicants respectfully submit that all claims are now in condition for allowance, and request that the Examiner pass this case to issuance. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

No fee is believed to be due in connection with this response. If, however, any fee is deemed to be payable, you are hereby authorized to charge any such fee to Deposit Account No. 20-0778.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Christopher D. Guinn", is written over a horizontal line.

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